



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,769	04/13/2001	John L. Robertson	2693	3757

26822 7590 03/25/2003

WALTER A. HACKLER
2372 S.E. BRISTOL, SUITE B
NEWPORT BEACH, CA 92660-0755

EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 03/25/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,769

Applicant(s)

ROBERTSON ET AL.

Examiner

Lyle A Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite as to how the sample metering means is structurally related to the "chamber" and "pocket". Additionally, the claim is vague and indefinite to what structure connects the metering means and testing assembly. Finally, the claim is vague and indefinite where and how the feed inlets communicate with the sample.

Claim 21 is vague and indefinite how the plurality of feed inlets communicate with the sample.

Claim 22 is vague and indefinite how the "slot" communicates with the sample.

Claim 23 is vague and indefinite how the chamber communicates with the remainder of the device (e.g. the sample, the feed inlets, sample pad, testing assembly, etc.).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 22-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lu et al. or May et al. (USP 5,656,503)

Art Unit: 1743

The invention is best understood, in light of the 35 USC 112 issues above, as an enclosed liquid assay device having a liquid receiving area in fluid communication with a testing means.

Lu et al. teach an analytical test device that includes a face plate(22) interlocking with base(23) that has been read on the claimed "casing". Lu et al. teaches port/hole(24) interconnected with distribution web(25) and test strips(26a-e) which have been read on the claimed "sample metering means for controlling ... feed elements... plurality of test elements". The web is pressed against the strips and has been read on the claimed "surface pressed against". The claimed "slots" have been read on port/hole(24).

May et al. teach an analytical device contained within a plastic casing that has been read on the claimed "casing". Sample receiving member(506) has been read on the claimed "sample pad". The dry porous carrier(510) has been read on the claimed "feed element". Both member(506) and carrier(510) are in fluid communication which has been read on the claimed "pressed" relationship.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lu et al. or May et al. alone or in view of Chipkowski.

See Lu et al. and May et al. *supra*.

The art is silent to a "plurality of spaced apart feed inlets".

Art Unit: 1743

The court decided St. Regis Paper Co. v. Bemis Co., Inc., (193 USPQ 8,11) that duplication of parts for a multiplied effect is within the skill of artisan.

It would have been within the skill of the art to modify Lu et al. or May et al. and provide a plurality of feed inlets to gain the advantage of multiple different tests being performed simultaneously.

Chipkowski teaches it is advantageous to use a test device having multiple feed inlets to simultaneously test for multiple analytes which saves time and money for the lab.

It would have been within the skill of the art to modify Lu et al. or May et al. in view of Chipkowski and use a plurality of spaced apart feed inlets to gain the above advantages.

Response to Arguments

Applicants' 1/28/03 remarks were not convincing.

Applicants' state the art does not teach the claimed metering means. As presently claimed, the Office has met all of the limitations of the metering means. Applicants' state the invention provides metering means sensitive to application of pressure. These remarks are not commensurate in scope with the pending claims because no means susceptible to pressure is claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1743

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander
Primary Examiner
Art Unit 1743

March 24, 2003